

REMARKS**I. Status of the Claims**

Claims 1 through 9 are pending. Claim 1, the sole independent claim, has been amended to address the rejection of this application maintained in the Advisory Action. Support for the amendment is found in the specification, particularly in paragraph 0022 and in Figs. 1 and 2. Entry of the amendment and favorable reconsideration are respectfully requested in light of these remarks.

II. Rejections Under 35 U.S.C. § 102(b)

The previously presented claims were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by the Hawkinson references. The amended claims are not anticipated by U.S. Patent No. 2,965,162 ("Hawkinson") or by U.S. Patent No. 3,528,476 ("Hawkinson, Jr.").

The Claimed Invention

The amended claims cover an apparatus for recapping tires comprising a first support structure for a tire to be recapped and a second support structure, associated with the first support structure, which supports tools for recapping the tire. The first support structure comprises a mandrel for support of the tire and a shaft for mounting the mandrel for rotation. The shaft is supported by a vertical upright on a carriage and is mounted for translation on the first support structure.

Recapping tools are mounted for translation on the second support structure. The direction of translation of the recapping tools is approximately perpendicular to that of translation of the mandrel. The direction of translation of the mandrel, vertical upright and carriage is parallel to the mounting shaft of the mandrel.

The Claimed Invention Is Not Anticipated By The Cited Art

Consideration of the Hawkinson references shows the important distinctions between the instant claimed invention and the cited art. Attention is invited to Hawkinson Figs. 1 and 2 and column 2 lines 5-23 where it is stated:

A rigid upright tubular pedestal 5 extends upwardly from the base 1 adjacent one side thereof, and is provided at its lower end with a mounting flange 6 that is rigidly secured to the base 1 by means of anchoring screws or the like 7. At its upper end, the pedestal 5 carries mechanism, indicated generally at 8, for rotatively mounting a shaft 9 on a horizontal axis, the mechanism 8 including an electric motor 10 and power transmission gearing not shown, but contained within a gear housing 11 for imparting rotary movement to the shaft 9. The shaft 9 is adapted to have mounted thereon a wheel 12 which carries a tire X to be buffed. The mechanism 8, together with the shaft 9, wheel 12, and tire X, is adjustable transversely of the pedestal 5, the mechanism 8 being mounted on a slide member 13 mounted in guideways 14 at the upper end of the pedestal 5, adjustment being had through the medium of an adjustment screw 15 to one end of which is secured a handwheel 15.

Note that the vertical upright pedestal 5 in Hawkinson is rigidly secured to the base by anchoring screws. Accordingly, there is no translation of the vertical upright in Hawkinson and thus, no “translation of the mandrel, vertical upright and carriage” “parallel to the mounting shaft of said mandrel” as required by Applicant’s claims. The absence of this claim element from the Hawkinson tire buffing machine means that Hawkinson is not an anticipatory reference in accordance with U.S.C. § 102(b).

The Examiner’s attention is also invited to U.S. Patent No. 3,528,476 (“Hawkinson, Jr.”) and in particular to Figs. 1, 2 and 10 and column 3, lines 28-72. Hawkinson, Jr. discloses a buffing machine 15 comprised of a base 16 and a first carriage means 17 mounted on the base. The carriage 17 includes a base portion 22 and a head portion 24 to which is mounted rotary shaft 18 on which is mounted tire casing A. Note that the direction of translation of the carriage means base portion 22, rotary shaft 18 and tire casing A is not parallel to the rotary shaft.

Nothing in Hawkinson, Jr. suggests “translation of the mandrel, vertical upright and carriage” “parallel to the mounting shaft of said mandrel” as required by Applicant’s claims. The absence of this claim limitation from the Hawkinson, Jr. buffing machine means that Hawkinson, Jr. is not an anticipatory reference in accordance with 35 U.S.C. § 102 (b).

In view of the fact that neither Hawkinson nor Hawkinson, Jr. is an anticipatory reference, it is respectfully requested that the 35 U.S.C. § 102(b) rejection be withdrawn.

The Claimed Invention Is Not Obvious In View Of The Cited Art

Claims 1-4, 6, and 7 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the Hawkinson references in view of U.S. Patent No. 3,675,706 (Cahill). Claim 7 has been rejected under 35 U.S.C. § 103(a) over these references further in view of the alleged admitted prior art. Claims 5, 8 and 9 are alleged to be unpatentable over these references and further in view of U.S. Patent Nos. 6,251,204 (Andersson), 4,036,677 (Marangoni), and 2,009,524 (Schmidt).

The Remarks in response to this rejection in Applicant’s Amendment dated April 8, 2004 are incorporated herein by reference. In addition, the Applicant notes that there is no suggestion in any of the references of elements in the amended claims, and thus, there is no *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the combined references must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both

be found in the prior art and must not be based on the applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991); MPEP § 2142.

In this case, there is no suggestion or motivation in any of the cited references to construct an apparatus for recapping tires wherein the direction of translation of the mandrel, vertical upright and carriage is parallel to the mounting shaft of the mandrel. The instant specification describes prior art tire recapping machines and problems of vibration and instability. The specification then notes in paragraph 0014 that:

The movement of translation of the mandrel parallel to its rotation shaft makes it possible to avoid exerting lateral forces on the mandrel, and to keep the center of gravity of the tire on a single axis, parallel to the said rotational shaft. This therefore prevents risks of deformation of the mandrel while assuring great stability during deformation of the latter, this stability being reinforced by the fact that the weight of the tire is always supported by the base of the frame, i.e., by the ground.

None of the references suggests Applicant's elegant solution to the problems of vibration and instability. Applicant further submits that a combination of the Hawkinson references and the other cited art, assuming that such combination would even be permissible, would fail to teach or suggest an apparatus for recapping tires wherein the direction of translation of the mandrel, vertical upright and carriage is parallel to the mounting shaft of the mandrel.

Accordingly, Applicant submits that Claim 1 is patentable over the cited art, and respectfully requests withdrawal of the rejection under 35 U.S.C. § 103(a). The other claims in the present application depend from Claim 1 and therefore are submitted to be patentable for at least the above reasons. Because each dependent claim is also deemed to define an additional aspect of the invention, individual consideration or reconsideration, as the case may be, of the patentability of each claim on its own merits is respectfully requested.

The present Amendment is believed clearly to place this application in condition for allowance. Should the Examiner believe that issues remain outstanding, it is respectfully

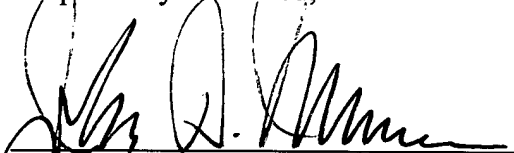
requested that the Examiner contact Applicant's undersigned attorney in an effort to resolve such matters and advance the case to issue.

In view of the foregoing amendments and remarks, Applicants earnestly solicit favorable reconsideration and early passage to issue of the present application.

CONCLUSION

Applicants' undersigned attorneys may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,



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